

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE LIN-HENDEL

Appeal 2007-1814
Application 09/619,255¹
Technology Center 3600

Decided: July 27, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and DAVID B. WALKER,
Administrative Patent Judges.

WALKER, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The application was filed on July 19, 2000 and claims the benefit of Provisional Application number 60/144,712, filed July 20, 1999.

STATEMENT OF THE CASE

Catherine Lin-Hendel (“Appellant”) seeks our review under 35 U.S.C. § 134 of the Examiner’s final rejection of claims 1-10 and 12-21. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.²

THE INVENTION

Appellant claims an electronic system for purchasing merchandise online, to mass-personalize and customize merchandise, and to provide online services for purchase, including personalized configuration, intelligent recommendations, guided selection, and simplified purchase processes (Specification 1:17-20). Claim 1, the only independent claim, is representative of the subject matter on appeal.

1. An electronic system for purchasing merchandise online using a computer having a display device, comprising:

means for selecting and purchasing merchandise, by a user, online; and

an interactive wizard guide, selectively and optionally deployed by the user, for making online merchandise recommendations and computer-assisted selections tailored to said user, said interactive wizard guide comprising:

² Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

means for prompting the user to specify preferences regarding at least one type of merchandise of interest to said user, said prompting means includes means for prompting the user to answer a plurality of questions,

means for receiving the preferences and answers to the plurality of questions to create a user profile,

means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise,

means, in response to said retrieving means, for displaying on said display device, said recommendations and said selections of said merchandise and said accessories, and

means for overriding said interactive wizard guide.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Hashimoto	US 5,729,699	Mar. 17, 1998
Danish	US 6,327,588 B1	Dec. 4, 2001
Weaver	US 6,404,426 B1	Jun. 11, 2002

The following rejections are before us for review.

1. Claims 1, 3-5, 9, 10, 16, and 20 are rejected under 35 U.S.C. § 102(e) as anticipated by Danish.

2. Claims 2, 6-8, 12-15, and 17-19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Danish in view of Official Notice and further in view of Weaver.
3. Claim 21 is rejected under 35 U.S.C. § 103(a) as unpatentable over Danish in view of Official Notice, in view of Weaver, and further in view of Hashimoto.

ISSUES

The issues before us are (1) whether Appellant has shown that the Examiner erred in rejecting claims 1, 3-5, 9, 10, 16, and 20 under 35 U.S.C. § 102(e) as anticipated by Danish; (2) whether Appellant has shown that the Examiner erred in rejecting claims 2, 6-8, 12-15, and 17-19 under 35 U.S.C. § 103(a) as unpatentable over Danish in view of Official Notice and further in view of Weaver; and (3) whether Appellant has shown that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 103(a) as unpatentable over Danish in view of Official Notice, in view of Weaver, and further in view of Hashimoto. The issues turn on whether the cited references disclose “means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise.”

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification describes a prior art category browsing process as lacking “artificial intelligence or process automation applied to enable or perform selection, recommendation, configuration, or custom order functions.” (Specification 4:17-18). It further describes a particular example of this prior art Internet shopping process, the purchasing of women’s apparel items from Shopping.Yahoo.Com, in which “[t]he viewer of the list performs the intelligence process: ‘browse’ the list, make judgment, select one item, click, wait, view the description page sent forth, make a decision, return to the list, pick another item, and repeat.” (Specification 5:6-9).
2. The Specification summarizes the invention as:

Interactive, intelligent process and rule-driven enquiry-database, intelligent product databases, artificial intelligence rules, data comparison algorithm, graphics and video design, composition, animation software, graphics and video input and output hardware and software, and/or video streaming are used to (1) guide consumers through needs and tastes definition process, (2) make recommendations, (3) narrow selections, (4) determine the fit, (5) configure and optimize various options of subsystems into a complete system, (6) layout, compose and/or animate, and (7) display the fitted system

of multiple items with the recommended and/or selected settings.

(Specification 8:15-22).

3. “An array of recommended items [is] sent by the Wizard to the shopper’s computer screen based on the shopper’s entry in 11B, as well as prior profiling knowledge of the shopper, and predetermined intelligence rules.” (Specification 14:22 - 15:1).

4. According to the Specification,

The present invention, the Wizard, uses interactive, rule-driven, intelligent databases, algorithm, and software, including but not limited to the following: (1) Interactive, intelligent, guided, categorically organized, and process- and rule- driven questionnaires tagged and stored in a database, to be deployed for defining individual shopper's needs and tastes; (2) intelligent product database with detailed descriptions, and pre determined rules of tagging and connectivity; (3) user-defined rules, (4) rule-base algorithms, (5) comparison software. The Wizard makes on-line merchandise recommendations and computer assisted selections tailored to each shopper's personal needs, tastes, and applications.

(Specification 15:15-23).

5. “The Wizard guides the intelligent information collection process with the shopper, compiles the information collected, search[es] the intelligent database for items [that] qualify the shopper’s intent, [and] make[s] the recommendation by displaying the items on the computer screen for the shopper.” (Specification 16:10-13). The Specification also teaches that: “Applying the current invention to Apparels and Accessories, the

Apparel Wizard solicits input from the shopper with well-designed menus and data entry tables. Based on the shopper input and pre-determined intelligence rules, the Wizard searches the product database, selects and recommends pertinent/qualified products and accessories.” (Specification 21:9-12).

6. Danish teaches a system for assisting the user in identifying a subfamily of items within a family of items by:

providing a computer readable data file of stored information representing at least one family of items, the data file identifying at least one alternative for each item, reading the data file, displaying a feature screen indicating said alternatives represented in the family, accepting selected alternatives, determining the subfamily of items where each item in the subfamily satisfies the selected alternatives, determining available alternatives represented in the sub-family and unavailable alternatives unrepresented in the subfamily, and revising the feature screen indicating the available alternatives as distinct from the unavailable alternatives.

(Danish, col. 3, ll. 54-65).

7. Danish does not disclose means for receiving preferences and answers to a plurality of questions from a user to create a user profile, nor does it teach a Wizard for using intelligence rules and a user profile to determine recommendations and selections of merchandise and accessories to the merchandise. (Danish, *passim*).

8. Weaver describes “the accurate rendering of a three-dimensional model of a person wearing clothing and illustrating the fit and movement of the clothing.” (Weaver, col. 1, ll. 5-9).
9. Weaver does not disclose means for receiving preferences and answers to a plurality of questions from a user to create a user profile, nor does it teach a Wizard for using intelligence rules and a user profile to determine recommendations and selections of merchandise and accessories to the merchandise. (Weaver, *passim*).
10. Hashimoto teaches a display apparatus that is capable of displaying evaluation data with respect to combinations of a pair of goods and colors and whether the combination of the goods and colors is appropriate (Hashimoto, col. 2, ll. 5-14).
11. Hashimoto does not disclose means for receiving preferences and answers to a plurality of questions from a user to create a user profile, nor does it teach a Wizard for using intelligence rules and a user profile to determine recommendations and selections of merchandise and accessories to the merchandise. (Hashimoto, *passim*).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

Appeal 2007-1814
Application 09/619,255

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art.

We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005)(en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)). We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)(“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”) The challenge is to interpret claims in view of the specification without unnecessarily importing limitations from the specification into the claims. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

A claim limitation will be interpreted to invoke 35 U.S.C. § 112, sixth paragraph, if it meets the following 3-prong analysis:

(A) the claim limitations must use the phrase “means for” or “step for;”

- (B) the “means for” or “step for” must be modified by functional language; and
- (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function.

MPEP § 2181, 8th ed. (August 2001). Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, ¶ 6 by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994).

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

ANALYSIS

We first construe the meaning of the phrase “means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” as used by the Appellant in claim 1. This limitation uses the words “means for” followed by a function, but fails to recite definite structure in support of the function. Such limitations are subject to the requirements of 35 U.S.C. § 112, ¶ 6. *See B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir.

1997) (“Because this limitation is expressed in ‘means plus function’ language and because it does not recite definite structure in support of its function, it is subject to the requirements of 35 U.S.C. § 112, ¶ 6 (1994).”). Therefore, we must look to the Specification and construe the “means” language as limited to the corresponding structure disclosed in the Specification and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994).

The plain language of claim 1 indicates that the “user profile” is created by “receiving the preferences and answers [from the user] to the plurality of questions.” (Appeal Br. 27). “[T]he examiner considers the phrase to mean any information that is saved (even temporarily) from a users [*sic*] session.” (Answer 7) This is contrary to the plain language of the claim. The plain language of claim 1 also specifies that the user profile thus created is used in combination with predetermined intelligence rules “for searching in and retrieving data from at least one database . . . to determine said recommendations and said selections of said merchandise and accessories to said merchandise.” (Appeal Br. 27).

The corresponding structure to perform the function “searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” is the Wizard. “The Wizard guides the intelligent information collection process with the shopper, compiles the information collected, search[es] the intelligent database for items [that] qualify the shopper’s intent, make the recommendation by displaying the items on the computer screen for the shopper.” (Finding of Fact 5) The Wizard

also uses “interactive, rule-driven, intelligent databases, algorithm, and software, including but not limited to the following: (1) Interactive, intelligent, guided, categorically organized, and process- and rule- driven questionnaires tagged and stored in a database, to be deployed for defining individual shopper's needs and tastes; (2) intelligent product database with detailed descriptions, and pre determined rules of tagging and connectivity; (3) user-defined rules, (4) rule-base algorithms, (5) comparison software.” (Finding of Fact 4). Giving the claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, we therefore construe “means for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” to mean a wizard or equivalent structure for searching in and retrieving data from at least one database using (1) a user profile created from preferences and answers received from the user to a plurality of questions and (2) predetermined intelligence rules. Because the disclosed structure, the wizard, makes on-line merchandise recommendations and computer assisted selections tailored to each shopper's personal needs, tastes, and applications using interactive, rule-driven, intelligent databases, algorithm, and software, (Finding of Fact 4), we agree with Appellant that a person of ordinary skill in the art “would have understood ‘using predetermined intelligence rules together with said user profile’ as application of at least some logic and reasoning to the profile information to determine the resulting recommendations.” (Reply Br. 7).

Based on this claim construction, the rejection of claims 1, 3-5, 9, 10, 16, and 20 as anticipated by Danish is improper, because Danish does not disclose each and every limitation as set forth in claims 1, 3-5, 9, 10, 16, and 20, either expressly or inherently. In particular, Danish fails to anticipate independent claim 1, because it does not does not teach any structure “for searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” (Finding of Fact 7). Danish interactively narrows the available options within a product family to a subfamily that meets user selected alternatives. It also shows unavailable alternatives based on user selections (Finding of Fact 6). It does not, however, disclose any structure for “searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” (Finding of Fact 7). Because Danish fails to disclose each limitation of independent claim 1, it also fails to anticipate dependent claims 3-5, 9, 10, 16, and 20.

The rejection of claims 2, 6-8, 12-15, and 17-19 as unpatentable over Danish in view of Official Notice and further in view of Weaver is also improper because each of those claims depends from claim 1 and contains the above discussed limitation that is missing from Danish. Weaver also fails to disclose any structure for “searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said

Appeal 2007-1814
Application 09/619,255

recommendations and said selections of said merchandise and accessories to said merchandise” (Finding of Fact 9). Examiner has provided no reference showing any such structure, nor has he made a prima facie case of obviousness over Danish in view of Official Notice and further in view of Weaver.

The rejection of claim 21 as unpatentable over Danish in view of Official Notice, in view of Weaver, and further in view of Hashimoto is improper for the same reason. Claim 21 depends from claim 1, and Hashimoto also fails to disclose any structure for “searching in and retrieving data from at least one database using predetermined intelligence rules together with said user profile to determine said recommendations and said selections of said merchandise and accessories to said merchandise” (Finding of Fact 11). The Examiner has provided no reference showing any such structure, nor has he made a prima facie case of obviousness over Danish in view of Official Notice, in view of Weaver, and further in view of Hashimoto.

CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-10 and 12-21.

Appeal 2007-1814
Application 09/619,255

DECISION

The decision of the Examiner to reject claims 1-10 and 12-21 is reversed.

REVERSED

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